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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/088,920

06/03/2002

Noriyuki Kizaki

025835-0104

8913

22428

7590

02/28/2005

FOLEY AND LARDNER
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EXAMINER

PAK, YONG D

ART UNIT

PAPER NUMBER

1652

DATE MAILED: 02/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/088,920

Applicant(s)

KIZAKI ET AL.

Examiner

Yong D Pak

Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-22 is/are pending in the application.
- 4a) Of the above claim(s) 1-4, 20 and 21 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5, 8, 9, 10-16 and 22 is/are allowed.
- 6) ☒ Claim(s) 17-19 is/are rejected.
- 7) ☒ Claim(s) 6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 November 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This application is a 371 of PCT/JP01/06619.

The amendment filed on November 22, 2004, amending claims 5-6, 9-10 and 17-18 and canceling claims 7 and 23, has been entered.

Claims 1-6 and 8-22 are pending. Claims 1-4 and 20-21 are withdrawn. Claims 5-6, 8-19 and 22 are under consideration.

Election/Restrictions

Claims 1-4 and 20-21 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement.

Drawings

Drawings submitted in this application are accepted by the Examiner for examination purposes only.

Claim Objections

Claim 6 is objected to because of the following informalities: the term "produce" in line 3 is unnecessary in describing the enzymatic activity of the encoded enzyme. Appropriate correction is required.

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Claim 6 is also objected for the recitation of "hybridizes to a nucleotide", in line 4. The claim should read as "hybridizes to a nucleotide sequences".

Response to Arguments

Applicant's amendment and arguments filed on November 22, 2004, have been fully considered and are deemed to be persuasive to overcome the rejections previously applied. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 17-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The terms "(pTSBH)", "(pTSBG1)" and "(pTSBH, pSTVG)" are unclear. It is not clear to the Examiner whether the terms in the brackets are labeled as names of the strains or to denote which vector the *E.coli* has.

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Claims 18-19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 18-19 are ultimate drawn to claim 5, which is drawn to a polynucleotide encoding the polypeptide of SEQ ID NO:1. However, the claims are additionally drawn to a polynucleotide encoding a glucose dehydrogenase. Therefore, the limitations of claims 18-19 and their dependencies from claim 5 do not correlate. It appears that applicants have meant claims 18-19 to depend from claim 14 and not from claim 16. Amending claims 18-19 to depend from claim 14 would overcome this rejection.

Claim 19 remains rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

It is apparent that the microorganism of *E. coli* HB101 (pSTVG) is required to practice the claimed invention. As a required element it/they must be known and readily available to the public or obtainable by a repeatable method set forth in the specification. If it/they is/are not so obtainable or available, the enablement requirements of 35 U.S.C. § 112, first paragraph, may be satisfied by a deposit of the microorganism(s). See 37 C.F.R. § 1.802.

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An affidavit or declaration by Applicants or someone associated with the patent owner who is in a position to make such assurances, or a statement by an attorney of record over his/her signature, and registration number, stating that the specific strain(s) has/have been deposited under the Budapest Treaty and that all restrictions imposed by the depositor on the availability to the public of the deposited material will be irrevocably removed upon the granting of a patent, would satisfy the deposit requirements. See 37 C.F.R. § 1.808.

Applicants argue that a deposit has been made and that the declaration filed on November 22, 2004 satisfies the requirement under 37 C.F.R. § 1.802. Examiner respectfully disagrees. The declaration filed on November 22, 2004 fails to mention *E. coli* HB101 (pSTVG). Therefore, the biological deposit requirements for *E. coli* HB101 (pSTVG) has not been met and the rejection has been maintained.

Allowable Subject Matter

Claims 5, 8-9, 10- 16 and 22 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong Pak whose telephone number is 571-272-0935. The examiner can normally be reached 6:30 A.M. to 5:00 P.M. Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on 571-272-0928. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-8300 for regular communications and 703-872-9307 for After Final communications.

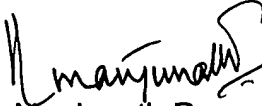
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.

Yong D. Pak
Patent Examiner 1652


Manjunath Rao
Primary Examiner 1652